SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1975

No. 75-1244

WILBUR T. BOLKCOM and WILLIAM E. KNAPP,

Petitioners,

v.

THE CARBORUNDUM COMPANY,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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No facet of this case warrants review by this Court.

The District Court and the Court of Appeals concurred in holding Claims 11 to 14 (the reissue claims) of Reissue patent No. 27,018 (hereinafter "patent '018") invalid under 35 U.S.C. §251 as not addressed to the invention disclosed in the original patent and, hence, an unauthorized enlargement of the disclosures of that patent. They also concurred in holding Claims 1 to 10 of that patent not infringed. Both Courts concurred in holding the doctrine of equivalents inapplicable because defendant's structure was not the equivalent of the transfer car arrangement of the patent. These holdings were predicated on *facts* found by the District Court and concurred in by the Court of Appeals.

None of the considerations governing review on *certiorari* set forth in Rule 19 is applicable here. The decision below is *not* in conflict with a decision of another Court of Appeals on the same matter or in conflict

with applicable decisions of this Court. Nor did the Court below decide a question of law "which has not been but should be, settled by this court." And there is nothing in the case calling for an exercise of the Court's power of supervision.

OPINIONS BELOW

The opinion of the United States District Court for the Eastern District of Tennessee, Northern Division, is not reported, but is reproduced as Appendix B, pages 14a-29a, to the petition, and the findings and conclusions of the District Court are also reproduced as a part of Appendix B, pages 30a-50a. The opinion of the Court of Appeals is reported at 523 F. 2d 492 and is attached to the petition as Appendix A.*

JURISDICTION

The jurisdictional requisites are set forth correctly in the petition.

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* For convenience, reference to either opinion will be to petitioners' appendix "App. p. ....." Italics and brackets within quotes are ours unless the contrary is noted.

QUESTIONS PRESENTED

Neither of the questions as stated by petitioners is present in this case. The Courts below correctly applied 35 U.S.C. §251, which governs the reissuance of patents, and did not engraft on that statute "additional legal criteria created by repealed statute §64, R.S. §4916 (1928)." Nor did the Courts below abrogate the doctrine of equivalents as enounced in *Graver Mfg. Co.* v. *Linde Co.*, 339 U.S. 605 (1950). On the contrary, the Courts below found the facts as required by that case and applied the legal principles thereof to those facts. Therefore, the question presented might more accurately and simply be stated:

> Where both lower Courts concurred on the facts in holding that the doctrine of equivalents was inapplicable and that the new claims of the '018 patent were invalid because they were not supported by the original application and were not addressed to the invention disclosed in the original patent and, hence, constituted an unauthorized enlargement of the disclosure of the original patent, is there any reason which would justify the intervention of this Court?

STATUTES INVOLVED

Section 251 of the 1952 Patent Act (35 U.S.C. §251), in relevant part, reads as follows:

> "Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.
>
> * * * * * *
>
> "No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent. July 19, 1952, c. 950, § 1, 66 Stat. 808."

Section 4916 R.S. (U.S.C., Title 35, Sec. 64), which was repealed by the 1952 Patent Act, insofar as pertinent, provides as follows:

> "Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and

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without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. . . . . Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in the case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid."

STATEMENT OF THE CASE

While petitioners' Statement of the Case, in large measure, is accurate, it nevertheless contains a number of misstatements and omissions relating to the reissue patent and the holdings of the Courts below.

In regard to reissue patent '018, petitioners state that Claims 11 to 14 enlarged the scope of the claims from the original patent to make the claims "commensurate with the broader description in the specification" and cover the embodiments described and equivalents thereof. This assertion ignores controlling findings made by the District Court and embraced by the Court of Appeals.

The District Court found (App. B, pp. 37a, 38a) that the specification and drawings of the original patent and of the reissue patent "do not illustrate or describe any transfer means other than a 'transfer car movable on a trackway extending transversely to the main trackway.'" It also found (App. B, pp. 44a-45a) that the original patent made no mention of any transfer arrangement other than that shown in the drawings and specifically disclosed in the specification, that there is "no support" in the original application or patent for any transfer arrangement other than one employing the transfer car and the transverse track arrangement shown, described and claimed therein, that the original patent and the representations made to the Patent Office in the procurement thereof "show that the patentees did not intend to cover or embrace any transfer arrangement except one employing a transfer car and trackways for the transfer car extending transversely, to the main trackway," and that the claims added by reissue are "not supported by the specification and drawings"

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and constitute an unauthorized enlargement of the disclosures of the original patent. These findings were found to be correct by the Court of Appeals. Both Courts held, as a result, that the claims of the reissue patent are "not addressed to the invention disclosed in the original patent" and, hence, are invalid.

In regard to the matter of equivalents, petitioners' statement is incorrect, inadequate and misleading. The District Court found (App. B, p. 43a) that, in view of the content of the specification and drawings of the original and reissue patents, the representations made to the Patent Office and the prior art, "plaintiffs' invention must be narrowly construed" and indeed was "narrowly accepted by the Patent Office in the context of the transfer car system." The Court also held (App. B, p. 46a) that respondent's Jacksboro plant does not embody a transfer car arrangement but instead employs a turntable, that a turntable is "a distinctly different mechanism from a transfer car," that the turntable system "is not the equivalent of the plaintiffs' invention whether considered in gross or whether the turntable device is specifically compared with the transfer car arrangement," and that respondent's turntable system "does not accomplish the same result in the same way; and it is an essentially different means since no transfer car is used." The Court went on to point out that the turntable employed by respondent was never disclosed or taught to be a part of the patented combination.

These holdings, which bar any finding of equivalency, were approved by the Court of Appeals which stated (App. A, p. 12a):

> "Applying this test [the test laid down by this Court in the *Graver* case, 339 U.S. 605], we hold that the district court's finding of fact that appellee's turntable was not the equivalent of the transfer car used in appellants' plant is not clearly erroneous."

The Court of Appeals went on to point out that a turntable functions differently than a transfer car and that important practical consequences may result from the differences between a turntable setup and a transfer car setup.

The conclusions of the Courts below ineluctably follow from the findings mentioned.

REASONS FOR DENYING THE WRIT

1. There Is No Conflict Between The Courts Of Appeals As To The Requirements Governing The Reissuance Of Patents Under Section 251; And The Courts Below Did Not Engraft Thereon "Additional Legal Criteria" As Set Forth In R.S. 4916.

In an effort to establish a conflict where none, in reality, exists, petitioners assert that there were "important changes" made when Section 251 was enacted as compared with the provisions prevailing theretofore and set forth in R.S. 4916. Petitioners (Pet., p. 12) set forth three alleged changes from the prior statutory law. None constitutes a change in the law.

Items 1 and 2 represent nothing more than the incorporation of appropriate wording in Section 251 to take care of bringing the statutory wording into exact consonance with the case law as enunciated by this Court. As to the third item, namely, that the new statute "eliminated the requirement that the claims of the reissue be 'for the same invention' as the original patent," petitioners' contention is completely unsound.

R.S. 4916 contained the requirements (a) that "no new matter" may be introduced into the case and (b) that the reissue patent be "for the same invention." These same requirements appear in Section 251. It expressly states that "No new matter" shall be introduced into the application and that the reissue must be "for the invention disclosed in the original patent." This last-mentioned requirement, namely, that the reissue be "for the invention disclosed in the original patent," means exactly the same thing as the words "for the same in-

vention" of the preceding statute. This has been recognized by the authorities.

Deller's *Walker on Patents,* Second Edition, 1965, Volume 4, §303, discusses the change in wording in the statutes. It points out that *only* "the same invention" can be covered by a reissued patent, that the Patent Act of 1952 changes the wording to "the invention disclosed in the original patent" and that "apparently no change of substance was intended." This section goes on to point out that the phrase "the same invention" occurred in all the former relevant statutory provisions, that it received various constructions, that this Court put a period to the controversy in *Parker and Whipple Co.* v. *Yale Clock Co.,* 123 U.S. 87, 99 (1887) and established the meaning of the phrase "the same invention" to be whatever invention was described in the original Letters Patent and appeared therein to be intended to be secured thereby, and that this rule has been repeatedly reaffirmed and reapplied by the Supreme Court and is "now embodied by the Patent Act of 1952, 35 USC § 251 (1958), as the 'invention disclosed in the original patent.' "

The legislative history contains no indication that any change was intended by the change in wording mentioned above. See *P. J. Federico's commentary on the new Patent Act,* 35 U.S.C., pp. 1, 44.

The cases decided subsequent to 1952 are to the effect that the requirements under the new Act are the same as those under the old Act as interpreted by this Court in *U. S. Chemicals Co.* v. *Carbide Corp.,* 315 U.S. 668 (1942) and in *Parker and Whipple Co.* v. *Yale Clock Co.,* 123 U.S. 87 (1887). In *Intermountain Research Co.,*

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Inc. v. *Hercules Inc.*, 163 U.S.P.Q. 390 (D.C. Cal., 1969), the Court stated (pp. 393-94):

> "Claims of a reissue patent are invalid unless they embrace only the very same invention which was intended or sought to be secured by the original patent. . . . It must appear from the face of the patent that all of what is covered by the reissue claims was intended to have been covered and secured by the original patent. . . .
>
> "The slight revision in the wording of Section 251, Title 35, U.S. Code, from its predecessor, R.S. 4916, does not change the substantive law regarding the reissuance of patents. The test of what type is required to warrant a valid reissue patent is the same as enunciated by the Supreme Court in U. S. Industrial Chemicals Co. v. Carbide Corp., 315 U.S. 668, 53 USPQ 6 (1942); Moist Cold Refrigerator Co. v. Lou Johnson Co., 217 F.2d 39, 103 USPQ 410 (9th Cir. 1954), cert. den. 348 U.S. 952, 104 USPQ 409, 356 U.S. 968, 117 USPQ 498."

Entirely apart from the change in wording just noted, petitioners' argument is ill-founded because the Courts below expressly found that the reissue claims in question were *not* "for the invention disclosed in the original patent" as required by Section 251. See Fact Findings 47 and 48 (App. B, pp. 44a, 45a) and Conclusion No. 8 (App. B, p. 49a). As will be seen, the Court expressly held that Claims 11 to 14 were not addressed "to the invention disclosed in the original patent," utilizing the language of Section 251, and that they, therefore, constituted an unauthorized enlargement of the disclosures of the patent and were invalid. The Court of Ap-

peals (App. A, p. 11a) held that the record clearly supports the District Court's conclusion.

Thus, it is clear that the Courts below were applying the criteria of Section 251 and were not "engrafting" on it anything from earlier statutes.

Petitioners' argument in respect of an alleged conflict is that the decisions of the Seventh Circuit and the Court of Customs and Patent Appeals conflict with the decisions in the Fourth, Ninth, Tenth and Sixth Circuits. An analysis of the cases in the Seventh Circuit and the CCPA relied upon by petitioners demonstrates that this is incorrect.

In *Hickory Springs Mfg. Co.* v. *Fredman Bros. Fur. Co., Inc.*, 509 F. 2d 55 (7 Cir., 1975), the Court held the reissue claim invalid because addressed to a different invention than that disclosed in the original patent. In *Kearney & Trecker Corp.* v. *Giddings & Lewis, Inc.*, 452 F. 2d 579 (7 Cir., 1971); Cert Den. 405 U.S. 1066, the Court held the reissue patent invalid, pointing out that any reissue must be predicated solely on the invention disclosed in the original patent. In *Maxant Button & Supply Co.* v. *Sears Roebuck & Co.*, 388 F. 2d 912 (7 Cir., 1968), the Court held the reissue patent invalid because the reissue specification and claim contained new matter having no antecedent in the original patent. In *Hazeltine Research* v. *Avco Manufacturing Corp.*, 227 F. 2d 137 (7 Cir., 1955); Cert. Den. 350 U.S. 987, the Court held that the invention covered by the original patent and that covered by the reissue patent were "one and the same." In *Weller Manufacturing Company* v. *Wen Products, Inc.*, 231 F. 2d 795 (7 Cir., 1956), the Court recognized that the invention covered by the reissue pat-

ent was the same as that covered by the original patent. In *Scovill Manufacturing Co.* v. *Goldblatt Brothers, Inc.,* 362 F. 2d 777 (7 Cir., 1966); Cert. Den. 385 U.S. 970, the reissue claims were held invalid *even though the drawings and descriptions of the original and reissue patents were identical.* The Court held that the unspecified form of the coupling member called for in the reissued claims was not disclosed in the original patent and was new matter alien thereto. In so holding, the Court noted (p. 780) that the *U. S. Chemicals* case was "dispositive" of this issue. *Application of Handel,* 312 F. 2d 943 (C.C. P.A., 1963) recognizes that the 1952 Act made no change in the law and that both prior to and subsequent to the passage of the 1952 Act the law required that the reissue be for the same invention, i.e., the invention disclosed in the original patent. *Application of Wesseler,* 367 F. 2d 838 (C.C.P.A., 1966) merely reaffirms the position taken in the *Handel* case.

Thus, there is nothing in these cases which conflicts with the decisions of the Court of Appeals in this case or the Courts in the Fourth, Ninth and Tenth Circuits.

2. The Doctrine Of Equivalents, As Enunciated By This Court, Was Not Abrogated But Was Correctly Applied By The Court Below.

In raising this issue, petitioners are asking this Court to review findings of fact by the Courts below.

In *Graver Mfg. Co.* v. *Linde Co.,* 339 U.S. 605 (1950), this Court considered the doctrine of equivalents, pointing out that what constitutes equivalency must be determined against the "context of the patent, the prior art, and the particular circumstances of the case." The Court then went on to point out factors to consider and stated (p. 609):

> "A finding of equivalence is a determination of fact."

As pointed out, *supra,* page 7, the District Court (App. B, p. 46a) found as a fact that a turntable "is a distinctly different mechanism from a transfer car," that respondent's turntable system "does not accomplish the same result in the same way; and it is an essentially different means since no transfer car is used," and that the turntable system "is not the equivalent of the plaintiffs' invention whether considered in gross or whether the turntable device is specifically compared with the transfer car arrangement." The Court of Appeals (App. A, p. 12a) expressly held that these findings were not clearly erroneous, that the turntable accomplishes the same function or result as the transfer car, but that it does so in a different way from that of a transfer car. It goes on to point out that important practical consequences may result from this difference. These findings lead to the conclusion that the doctrine of equivalents is inapplicable here.

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Conclusion.

Thus, contrary to petitioners' suggestion, the Courts below did not abrogate the doctrine of equivalents; and the "viability" of the doctrine is in no way at issue here.

CONCLUSION

The petition should be denied.

Respectfully submitted,

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